

Appl. No. : **09/344,526**
Filed : **June 24, 1999**

REMARKS

Claims 16-20, 59-65, 75-105 and 108-140 are pending. Claims 1-15, 21-58, 66-74, 106 and 107 are cancelled without prejudice or disclaimer. Claims 16, 19, 75, 80, 93 and 108 have been amended. In particular, claims 16, 19, 75 and 80 have been amended to replace the term "particle" with the term "bead." Claim 93 has been amended incorporate the limitation recited in previously pending, but objected to, claim 107, which recites "wherein said sites are present in a depression." Finally, claim 108 has been amended to depend from claim 93 rather than claim 107, which is now canceled. Support for each of these claim amendments can be found throughout the specification and in the claims as originally filed. For example, support for the amendments to claims 16, 19, 75 and 80 can be found at page 9, line 32 to page 10, line 8.

New claims 109-140 have been added. Claims 109 and 123 are independent. Claim 109 is an independent claim that recites elements identical to those of claim 93 except that the phrase "wherein said sites are present in a depression" has been replaced with the phrase "wherein said sites comprise wells." Support for claim 109 can be found in the specification at page 8, line 6 to page 9, line 5 and elsewhere throughout the specification. Claims 110-122 depend from claim 109. Claim 123 is an independent claim that is similar to amended claim 16 but includes the following two differences. First, step (a) of claim 123 includes the limitation "wherein said sites comprise wells." This limitation is not present in amended claim 16. Second, claim 123 recites the term "particle" rather than the term "bead" as used in amended claim 16. Support for claim 123 can be found, for example, at page 8, line 6 to page 10, line 8 and elsewhere throughout the claims and specification as originally filed. Claims 124-140 depend from claim 123.

Support for each of the newly added dependent claims can be found in the claims as originally filed and/or throughout the specification. For example, support for dependent claims 111-115 and 130-132 can be found at page 10, lines 26-35 and elsewhere throughout the specification. Support for dependent claims 116-119, 134, 135, 138 and 139 can be found at page 17, line 15 to page 18, line 17 and elsewhere throughout the specification. Support for dependent claims 120, 121 and 140 can be found at page 7, line 26 to page 8, line 4 and elsewhere throughout the specification. Dependent claim 122 is supported at page 8, lines 6-23 and elsewhere throughout the specification. Support for dependent claims 128, 129 and 133 can be found at page 9, lines 26-30, page 17, lines 15-26 and elsewhere throughout the specification.

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Dependent claim 136 is supported at page 18, lines 23-32 and elsewhere throughout the specification. Finally, support for new claims 110, 124-127, and 137 can be found in the claims as originally filed and elsewhere throughout the specification.

Rejection of claims 16-20 and 75-87 under 35 U.S.C. § 112, second paragraph

Claims 16-20 and 75-87 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner asserts that the claims are drawn to methods of making a microsphere array but the actual claim steps recite the use of “particles” rather than “microspheres.”

To expedite the allowance of the instant claims, Applicants have amended the preamble of claim 16 to recite “a method of making a bead array.” The claim has also been amended such that the steps appearing in the body of the claim now recite “beads” rather than “particles.” Where appropriate, dependent claims 17-20 and 75-87 have been amended to replace the term “particles” with the term “beads.”

In view of the foregoing, Applicants respectfully request that the Examiner withdraw his rejection of claims 16-20 and 75-87 under 35 U.S.C. § 112, second paragraph.

Rejection of claims 16, 18, 75-82, 84-87, 93-102, 104 and 105 under 35 U.S.C. § 103(a)

Claims 16, 18, 75-82, 84-87, 93-102, 104 and 105 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 5,326,691 (Hozier). In particular, the Examiner asserts that Hozier describes the production and utilization of micro-libraries of cells at high densities in a definite two-dimensional pattern. The Examiner further asserts that Hozier describes the use of DNA, protein and other various molecules in screening methods, wherein the screening methods are performed with staining via binding ligands to cell features. The Examiner then contends that the subject matter described in claims 16, 18, 75-82, 84-87, 93-102, 104 and 105 would have been obvious to one of ordinary skill in the art because Hozier’s asserted generic disclosure of array preparation practices allegedly suggests and motivates specifically described species.

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Applicants maintain that the subject matter recited in claims 16, 18, 75-82 and 84-87 is nonobvious over Hozier, however, to expedite the allowance of the instant claims, Applicants have amended claims 16, as well as claims depending therefrom, to replace the term "particles" with the term "beads." Hozier does not describe or suggest the subject matter of amended claim 16, or its dependent claims 18, 75-82 and 84-87, because Hozier does not disclose or suggest methods of making an array that comprises beads. Rather, Hozier only discloses making a "micro-library" by growing "micro-colonies" of living organisms on the surface of a substrate. Hozier specifically defines micro-library as a "population of individual cells or small sub-populations of individual cells (micro-colonies), the members of which differ from each other in their genotype and/or their phenotype." *See* Hozier at column 7, lines 23-27. Furthermore, Hozier specifically defines micro-colonies as "subpopulations of clonally derived cells that form elements of the population of a micro-library." *See* Hozier at column 7, lines 7-10. Hozier does not describe or suggest methods of making an array that comprises non-living particles, such as beads. Accordingly, Applicants respectfully submit that amended claims 16, 18, 75-82 and 84-87 are patentable over Hozier.

In addition to the foregoing, Applicants respectfully submit that amended claims 93-102, 104 and 105 are nonobvious over Hozier. Applicants have amended claim 93 and claims depending therefrom to contain the limitation that "said sites are present in a depression." This limitation was previously included in dependent claim 107, which the Examiner stated would be allowable if re-written as an independent claim. Claim 93 and the claims depending therefrom, including claims 94-102, 104 and 105, now each recite the limitation that "said sites are present in a depression." As such, Applicants respectfully submit that amended claims 93-102, 104 and 105 are patentable over Hozier.

In view the scope of allowed claims 59-65 and 88-92, Applicants respectfully submit that each of the newly added claims (claims 109-140) is also allowable. Accordingly, Applicants respectfully request that the Examiner enter each of the foregoing amendments and newly presented claims, and then, move the application to allowance.

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CONCLUSION


Applicants believe that all outstanding issues in this case have been resolved and that the present claims are in condition for allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is invited to contact the undersigned at the telephone number provided below in order to expedite the resolution of such issues.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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